

REMARKS

The applicant notes with appreciation the allowance of claims 30-32, 34-41 and 50-58 along with previously allowed claims 42-44; and further, the withdrawal of an objection to the disclosure raised in the previous action. Reconsideration of claims 45-48 is respectfully requested.

A. Claims 59-62 are subject to an objection, as allegedly directed to an invention independent or distinct from that originally claimed.

The present amendment cancels claims 59-62. While this amendment confirms the withdrawal of these claims and indicates the applicant's acceptance of the withdrawal, it does not necessarily indicate agreement with the underlying conclusion that the claims constitute an invention independent or distinct from the claims at issue.

B. Claims 45-49 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,697,969, Schmitt et al.

The Schmitt patent discloses a vascular prosthesis with a plurality of braided layers, each layer including at least one interlocking yarn extending from its own layer into another layer to form an interlock with the other layer. The braided layers may include substantially resorbable layers, and substantially non-absorbable layers.

In connection with this rejection, the present action notes that Schmitt shows using two mandrels having different diameters. Indeed, examples 4, 5 and 6 (see column 6) involve forming five-layer prostheses on 6 mm diameter mandrels, then placing the prostheses on smaller mandrels (5 mm or 4.75 mm diameters) for heat treatment.

The above notwithstanding, there is no indication in Schmitt as to why the prostheses in the featured examples are heat set on smaller diameter mandrels. More to the point, there is no teaching in Schmitt of any relationship between the diameter at which any one of the its prostheses is heat treated, and the radially outward force to be exerted by the prosthesis when radially compressed to a predetermined fraction of its heat treated diameter.

Further, there is no disclosure in Schmitt from which one skilled in the art might infer any relationship between the diameter of a prosthesis during heat treating, and the radially outward force exerted by the heat treated prosthesis at a fraction of its diameter, predetermined or otherwise. Schmitt does not concern itself with radially outward forces exerted by its prostheses.

Rather, Schmitt deals with the capability of its prostheses to exert radially inward forces to counteract internal positive pressure. Note the charts of Figures 15A-15F, and see column 7. This is not surprising, given the vascular-replacement function of Schmitt's prostheses. Even here, Schmitt does not teach or suggest any relationship between the radially inward force exerted by a given prosthesis, and the diameter at which it was heat treated.

Claim 45 was previously amended to incorporate subject matter of claim 49, now cancelled. Specifically, the process defined in claim 45 includes the step of selecting a second mandrel having a second diameter less than the first diameter for annealing the prosthesis structure. Further, the second mandrel is selected to provide for annealing the prosthesis structure at a diameter D based on a predetermined radially outward force to be exerted by the annealed structure when radially compressed to a predetermined fraction of the annealed diameter D.

Thus, the process involves more than simply selecting a smaller mandrel for the annealing step. It requires selecting a certain mandrel size, i.e. the size that enables and facilitates annealing the prosthesis at the particular diameter D that determines the radially outward force exerted by the annealed prosthesis when radially compressed to a predetermined fraction of diameter D.

Anticipation requires that a single prior art reference, in this case the Schmitt patent, disclose every limitation of the claim. PPG Industries v. Guardian Indus. Corp., 75 F.3d 1558, 37 U.S. P.2d 1618 (Fed. Cir. 1996). The Schmitt patent falls short of this standard, and thus does not anticipate the process defined in claim 45.

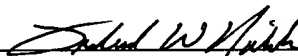
Claims 46-48 depend on claim 45, and are patentable for the reasons given in support of claim 45.

To summarize, it is submitted that claims 45-48, along with presently allowed claims 30-32, 34-44 and 50-58, incorporate subject matter patentable over the prior art of record. This amendment cancels claims 59-62, but otherwise does not change the claims. Accordingly, the amendment does not touch upon the merits of the application, nor does it require any further searching on the part of the examiner. Rather, the amendment places the claims in better form for allowance or for consideration on appeal. Accordingly, the applicant respectfully requests an early and favorable action entering the proposed amendment and allowing claims 30-32, 34-48, and 50-58.

Respectfully submitted,

Boston Scientific Scimed, Inc.

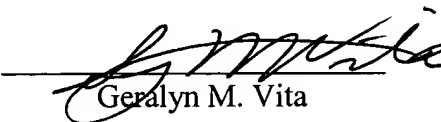
Dated: October 24, 2003

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CERTIFICATE OF MAILING

Pursuant to 37 CFR 1.8, I hereby certify that this Amendment Pursuant to 37 C.F.R. 1.116 in Application Serial No. 09/843,425 is being deposited with the U.S. Postal Service by first class mail, postage prepaid, in an envelope addressed to: Mail Stop, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of deposit indicated below.

Date of Deposit: October 24, 2003


Geralyn M. Vita

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